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obvious over Dahlgren (U.S. Patent No. 4,208,963) under 35 U.S.C. § 103.

As will be explained below, it is believed that the claims were patentable over the cited art in their original form and, therefore, the claims have not been amended to overcome the references.

Before discussing the prior art in detail, it is believed that a brief review of the invention as claimed, would be helpful. Claim 10 calls for, *inter alia*, a printing machine including:

at least one roller with a circumferential surface provided with a surface structure and formed of a nonmetallic material, the roller selected from a slip roller and a vibrator roller.

Similarly, claim 1 calls for, *inter alia*, a rotatable body for printing machines, the rotatable body including:

a circumferential surface provided with a surface structure and formed of a nonmetallic material, the circumferential surface being a roller selected from a slip roller and a vibrator roller.

Dahlgren describes three rollers: an ink storage roller 82; a material conditioning roller 86; and an ink storage roller 94. The Examiner initially refers to these three rollers as "vibrator rollers," apparently because such a reference exists in col. 7 at line 60. However, these rollers are erroneously identified as "vibrator rollers" in the Dahlgren description. A "vibrator roller" (as one having ordinary skill in the art would refer to it) actually is a roller that periodically comes into contact with another roller. The specification of the instant application defines such a roller on page 5, line 24, to page 6, line 12, as well as page 8, lines 21 to 26.

Lines 62 and 63 of col. 7, however, correctly characterize the operation of Dahlgren rollers 82, 86, and 94 by stating that the rollers "oscillate . . . in a longitudinal direction." Because the rollers 82, 86, and 94 oscillate in an axial direction, the correct characterization of these rollers 82, 86, and 94 is the expression: "distributor roller."

Immediately after describing the rollers 82, 86, 94 as vibrator rollers, the Examiner appears to have realized the inaccuracy in Dahlgren because the rollers 82, 86 and 94 are equated not with the vibrator roller mentioned in the instant application but with the slip roller of the instant application. See the rejection of claims 1 to 3 and 5 to 10 on page 2 of the Office action.

Nevertheless, one having ordinary skill in the art would know that such a comparison is incorrect.

Dahlgren rollers 86 and 94 unroll on the roller 90 (see FIG. 1) and are friction driven by the surface of roller 90. See Dahlgren at col. 7, lines 65 to 68. One having ordinary skill in the art knows that such reeling off typically takes place without slip between the roller 86 and the roller 90 and also without slip between the roller 94 and the roller 90. Thus, they cannot be considered as the slip roller of claims 1 or 10 of the instant application.

In contrast to what is referred to in the art as a slip roller and what the instant application refers to as a slip roller, roller 82 is not driven without friction but through a toothed gearing. See Dahlgren at col. 7, lines 67 to 68. Nowhere is there any hint in Dahlgren that a slip exists between the roller 82 and the roller 10.

It is accordingly believed to be clear that none of the references, whether taken alone or in any combination, either show or suggest the features of claims 1 or 10. Claims 1 and 10 are, therefore, believed to be patentable over the art. The dependent claims are believed to be patentable as well because they all are ultimately dependent on claim 1.

With regard to claim 3, the Examiner states that one of the Dahlgren rollers 82, 86, 94 is in constant contact with two other rollers. However, in contrast to the Examiner's assertion, there is no mention in Dahlgren that one of the rollers 82, 86 and 94 is in contact with two other rollers as set forth in claim 3 of the instant application. As shown in FIG. 1 of Dahlgren, each of the rollers 82, 86, and 94 is only in contact with a single roller, specifically, either roller 10 or roller 90. Thus, Dahlgren cannot be said to suggest the features of claim 3 of the instant application.

In paragraph 3 on page 2 of the above-identified Office action, claim 4 has been rejected as being obvious over Dahlgren in view of Johne et al. (U.S. 4,033,262; hereinafter "Johne") under 35 U.S.C. § 103.

Johne is discussed in the introduction of the specification of the instant application. Even though Johne (see FIG. 3 therein) illustrates a roller 8, the surface structure of which having a winding groove, the rejection of claim 4 does not provide any argument that the Johne roller 8 can be used instead of one of the Dahlgren rollers 82, 86, and 94. In order to make such argument, however, there must be motivation to do so.

When "it is necessary to select elements of various teachings in order to form the claimed invention, we ascertain whether there is any suggestion or motivation in the prior art to make the selection made by the applicant". Interconnect Planning Corp. v. Feil, 227 USPQ 543, 551 (Fed. Cir. 1985) (emphasis added). "Obviousness can not be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching, suggestion or incentive supporting the combination". In re Bond, 15 USPQ2d 1566, 1568 (Fed. Cir. 1990). "Under Section 103 teachings of references can be combined only if there is some suggestion or incentive to do so." ACS Hospital Systems, Inc. v. Montefiore Hospital et al., 221 USPQ 929, 933, 732 F.2d 1572 (Fed. Cir. 1984) (emphasis original). "Although a reference need not expressly teach that the disclosure contained therein should be combined with another, the showing of combinability, in whatever form, must nevertheless be 'clear and particular.'" Winner Int'l Royalty Corp. v. Wang, 53 USPQ2d 1580, 1587, 202 F.3d 1340 (Fed. Cir. 2000) (emphasis added; citations omitted); Brown & Williamson Tobacco Corp. v. Philip Morris, Inc., 56 USPQ2d 1456, 1459 (Fed. Cir. Oct. 17, 2000). There is no "clear and particular" teaching or suggestion in Dahlgren to incorporate the features of Johne, and there is no teaching or suggestion in Johne to incorporate the features of Dahlgren. This is probably why the Examiner fails to include such an argument.

In establishing a *prima facie* case of obviousness, it is incumbent upon the Examiner to provide a reason why one of ordinary skill in the art would have been led to modify a prior art reference or to combine reference teachings to arrive at the claimed invention. Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Int. 1985). To this end, the requisite motivation must stem from some teaching, suggestion, or inference in the prior art as a whole or from the knowledge generally available to one of ordinary skill in the art and not from the applicants' disclosure. See, for example, Uniroyal, Inc. v. Rudkin-Wiley Corp., 837 F.2d 1044, 1052, 5 USPQ2d 1434, 1439 (Fed. Cir. 1988), *cert. den.*, 488 U.S. 825 (1988). The Examiner has not provided the requisite reason why one of ordinary skill in the art would have been led to modify Dahlgren or Johne or to combine Dahlgren's and Johne's teachings to arrive at the claimed invention. Further, the Examiner has not shown the requisite motivation from some teaching, suggestion, or inference in Dahlgren or Johne or from knowledge available to those skilled in the art.

Applicants respectfully believe that any teaching, suggestion, or incentive possibly derived from the prior art is only present with hindsight judgment in view of the instant application. "It is impermissible, however, simply to engage in a hindsight reconstruction of the claimed invention, using the applicant's structure as a template and selecting elements

from references to fill the gaps. . . . The references themselves must provide some teaching whereby the applicant's combination would have been obvious." In re Gorman, 18 USPQ2d 1885, 1888 (Fed. Cir. 1991) (emphasis added). Here, no such teaching is present in the cited references.

Johne's roller 8 is not only a slip roller, but also a vibrator roller. In FIG. 1 of Johne, reference numeral 9 clarifies a tilting movement, due to which the roller 8 periodically comes in contact with the ink fountain roller 3, as it is typical for a vibrator roller. See Johne at col. 2, lines 55 to 58.

One having ordinary skill in the art is aware that the Dahlgren rollers 86 and 94 must be permanently attached at the roller 90 (i.e., not periodically) so that the ink film that is located thereon is smoothened. See Dahlgren at col. 7, lines 26 to 28, as well as lines 31 to 33. It would be disadvantageous to the smoothing of the ink film, if the rollers 86 and 94 were to come into periodical contact with a different roller other than the roller 90. Thus, it would be improper to combine Johne with Dahlgren because the two references teach away from one another.

One having ordinary skill in the art is also aware that the roller 82 must be in permanent (i.e., not periodical) contact

to the roller 10 because the toothed wheels of the rollers 82, 10 (see Dahlgren at col. 7, lines 67 to 68) would no longer be in tooth contact with each other when the roller 82 is turned on or off. Therefore, again, John teaches away from Dahlgren.

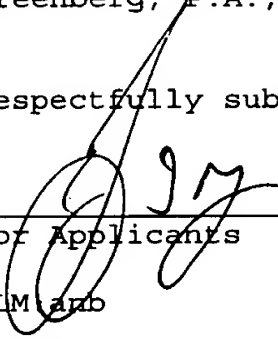
For all of these reasons, claim 4 is not suggested by the cited prior art references.

In view of the foregoing, reconsideration and allowance of claims 1 to 10 are solicited.

In the event the Examiner should still find any of the claims to be unpatentable, counsel would appreciate receiving a telephone call so that, if possible, patentable language can be worked out.

Please charge any fees that might be due with respect to
Sections 1.16 and 1.17 to the Deposit Account of Lerner and
Greenberg, P.A., No. 12-1099.

Respectfully submitted,



For Applicants

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January 3, 2002

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